



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/449,001	11/24/1999	PAUL SENN	BCK-201	5697
207	7590	05/18/2006	EXAMINER	
WEINGARTEN, SCHURGIN, GAGNEBIN & LEOVICI LLP TEN POST OFFICE SQUARE BOSTON, MA 02109			TRAN, PABLO N	
			ART UNIT	PAPER NUMBER
			2618	

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/449,001	SENN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Pablo N. Tran	2618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 29 August 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-22,24-28,30-33,35-38 and 40-56 is/are pending in the application.
- 4a) Of the above claim(s) 23,29,34 and 39 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-22,24-28,30-33,35-38 and 40-56 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-22, 24-28, 30-33, 35-38, and 40-56 rejected under 35 U.S.C. 102(e) as being anticipated by Kirby (6,330,443).

As per claims 1 and 12, Kirby disclosed a system for allowing a subscriber to a prepaid communication service to roam between a different service markets comprising a serving MSC (fig. 1/no. 20, 60) capable of communicating with a roaming subscriber's phone unit (fig. 1/no. 80a, 80c) and capable of generating a request for a profile associated with the subscriber (col. 14/ln. 27-31), a location register (fig. 1/no. 28-29, 48-49, col. 12/ln. 45-67) in communicating with the serving MSC and HLR (fig. 1/ln. 43) collecting the subscriber profile and determined whether a prepaid platform is associated with the respective market of the serving MSC (fig. 1, where it is clear that National Debit Platform 70 is associated with serving MSC 60 and debit platform 26 is associated with serving MSC 20) and selectively modifying (the requested and collected

subscriber profile based on whether a prepaid platform is associated with the respective market the serving MSC, a prepaid platform (fig. 1/no. 26, 46, 72), where the selective modification of the requested and collected subscriber profile by the location register is for enabling the serving MSC to employ the prepaid platform associated with the respective market and thereby to enable the provision of prepaid services to the roaming subscriber (as shown in fig. 1, it is clear that for roaming subscriber 80c, the serving MSC 60 employed prepaid platform 72 and for roaming subscriber 80a, the serving MSC will employed prepaid platform 26)

As per claims 2 and 13, Kirby disclosed the location register includes a database (col. 12/ln. 1-13, 45-67) having information representative of prepaid platforms associated with a plurality of markets capable of servicing the subscriber having a prepaid platform associated therewith .

As per claims 3 and 14, Kirby disclosed the location register includes a message-processing unit (col. 12/ln. 45-67) for processing a message from the serving MSC for identifying whether a prepaid platforms is associated with the respective market f the serving MSC .

As per claims 4 and 15, Kirby disclosed the serving MSC includes a profile request service capable of requesting a user profile in response to receipt of an NPA/NXX signal representative of the subscriber being a prepaid customer (TABLE A-F).

As per claims 5 and 16, Kirby disclosed the location register includes a memory space (col. 12/ln. 45-67) for storing information representative of a location associated with the subscriber.

As per claims 6 and 17, Kirby disclosed the location register includes means for providing a HLR with information representative of a location associated with the subscriber (col. 4/ln. 20-35).

As per claims 7 and 18, Kirby disclosed the location register includes means for passing through registration requests for subscribers identified as non-prepaid subscribers (col. 9/ln. 55-col. 10/ln. 19).

As per claims 8 and 19, Kirby disclosed the location register includes means for requesting subscriber location information from a HLR associated with the subscriber (col. 12/ln. 1-13, 45-67).

As per claim 9, *Kirby disclosed* the location register includes is in communication with the prepaid platform for delivering subscriber location information to the prepaid platform (col. 12/ln. 1-13, 45-67).

As per claims 10 and 20, Kirby disclosed the location register includes means for communicating with a VLR to allow call termination for a call (fig. 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 24/ln. 29-col. 26/ln. 62).

As per claim 11, Kirby disclosed the location register includes an error reporter for reporting detected error conditions to the prepaid platform (col. 18/ln. 44-col. 19/ln. 5).

As per claims 21, 28, 33, and 38, Kirby disclose all the claimed limitation as stated above in claim 1, Kirby further disclosed that based on whether a prepaid platform is associated with the respective roaming market, modifying the subscriber profile to route the call to at least one of a prepaid platform located in the respective market for the serving MSC or to a prepaid platform located in a market different than the respective market (fig. 1 , 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 24/ln. 29-col. 26/ln. 62).

As per claims 22 and 44, Kirby disclosed the call originates from at least one of a mobile telephone or a landline (fig. 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 24/ln. 29-col. 26/ln. 62).

As per claims 24, 30, 35, 47-48, and 53-54, Kirby disclosed modifying the profile associated with the subscriber to route the call to at least one of a prepaid platform located in the respective market associated with the serving MSC for the serving MSC to complete the call (fig. 1, 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 24/ln. 29-col. 26/ln. 62).

As per claims 25, 27, 31, 36, 41, and 45, Kirby disclosed modifying the profile associated with the subscriber to route the call to a hotline (toll-free) number on a PSTN (col. 18/ln. 44-col. 19/ln. 5).

As per claims 26, 32, 37, 42-43 46, 49-52, and 55-56 Kirby disclosed modifying the profile associated with the subscriber to include a hotline (toll-free) number for a prepaid platform located in a market different than the respective market for the MSC

(fig. 1, 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 18/ln. 44-col. 19/ln. 5, col. 24/ln. 29-col. 26/ln. 62).

As per claim -40, Kirby disclosed modifying the profile associated with the subscriber to route the call to a prepaid platform located in the respective market for the serving MSC (fig. 1, 3-5, col. 4/ln. 20-35, col. 10/ln. 1-35, col. 24/ln. 29-col. 26/ln. 62).

### **Conclusion**

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pablo Tran whose telephone number is (571)272-7898. The examiner normal hours are 9:30 -5:00 (Monday-Friday). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban, can be reached at (571)272-7899. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

4. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) System. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PABLO N. TRAN  
PRIMARY EXAMINER



AV2618

May 10, 2006